

Application No.: 09/942,250

Docket No.: 60680-1187

REMARKS

Applicant has carefully reviewed the Office Action mailed October 3, 2004, and thanks Examiner Lee for his detailed review of the pending claims. In response to the Office Action, Applicant has amended claims 1, 3-7, and 12, and added new claims 13-14. By way of this amendment, no new matter has been added. Accordingly, claims 1-14 remain pending in this application. Applicant respectfully requests reconsideration of the present application in view of the above amendment, the new claims, and the following remarks.

I. Rejection of claims 1-10 under 35 U.S.C. § 112

The Office Action rejected claims 1-10 under 35 U.S.C. § 112, second paragraph. More particularly, the Office Action rejected claims 1-10 because it was unclear to the Examiner if the insert and the blank metal substrate are the same. Claim 1 clearly recites an insert formed by supplying an elastomeric material to a blank metal substrate, therefore, the insert and the blank metal substrate are not the same, rather the blank metal substrate is a portion of the insert. Claims 3-6 have been amended to clarify the respective references to a 'body' by replacement with either 'insert' or 'blank metal substrate.' Should the Examiner still have concerns, the courtesy of a telephone discussion to jointly develop language to address the Examiner's concern is respectfully requested.

II. Rejection of claims 1-5 and 11 under 35 U.S.C. § 102(b)

Claims 1-5 and 11 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,096,228 to Decker ("Decker"). The rejection is respectfully traversed.

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Application No.: 09/942,250

Docket No.: 60680-1187

As amended, independent claim 1 positively recites applying a second force to "bend at least one finger extending from said blank metal substrate." In contrast, Decker does not disclose this limitation. The claimed invention reduces the number of forming operations required to make a final product by combining a metal forming process with a molding process such that a blank metal substrate is shaped into a desired shape in the same mold where an elastomeric material is supplied and then cured into its final shape.

For at least this reason, claim 1 and also claim 11, are patentable over the prior art of record. While claims 2-5 and 12 are patentable since claim 1 is patentable, they are also independently patentable.

III. Rejection of claim 12 under 35 U.S.C. § 102(b)

Claim 12 was rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,096,228 to Decker ("Decker"). The rejection is respectfully traversed.

In reference to claim 12, the Examiner states that "Decker teaches the claimed process as evidenced by FIGS. 1-5." Independent claim 12 includes the limitation "wherein said predetermined portions of said metal substrate include opposing, generally planar outer surfaces, and said elastomeric material extends away from said outer surfaces." In contrast, Decker teaches a gasket with material that extends away from a gasket on surfaces that are not opposing, generally planar outer surfaces.

IV. Rejection of claims 6-10 under 35 U.S.C. §103(a)

Claims 6-10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Decker. The rejection is respectfully traversed.

When rejecting a claim based upon a sole 35 U.S.C. 103(a) reference, the Federal Circuit has provided some guidance. Specifically, *In re Gordon* provides that "[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." 221 USPQ 1125, 1127 (CAFC 1984).

Application No.: 09/942,250

Docket No.: 60680-1187

In addition, the Federal Circuit has held that “[i]t is not pertinent whether the prior art device possesses the functional characteristics of the claimed invention if the reference does not describe or suggest its structure.” *In re Mills*, 16 USPQ2d 1430, 1433 (1990). Emphasis added

At the outset, the remarks above with respect to the rejection of Claims 1-5 are equally applicable to this rejection. The Office Action acknowledges that Decker does not teach “*using an insert having radially extending arms; using an insert having arms wherein at least one of the arms has an offset elbow; using an elbow that provides a connection between the arm and a shoulder portion of the insert wherein the shoulder portion is contiguous with the peripheral edge of the closed loop of the insert*” (see Office Action dated October 3, 2003 at page 3 lines 12- 16). The Examiner further states that Claims 6-10 are not steps of the claimed process. Claim 6 has been amended to clarify that the formation of the sealing bead is a step of the claimed method, and claim 7 has been amended to clarify that offset elbow is formed during a step of the claimed method. Claims 8-10 further limit the steps of the claimed method. Thus, claims 6-10 are patentable over the prior art of record independently of the fact that they are dependent on claim 1.

The Examiner is respectfully requested to provide the motivation within the prior art to make the modification suggested.

V. New Claims 13 and 14

Newly added Claim 13 includes the limitation “supplying an elastomeric material to selected predetermined portions of said blank metal substrate, wherein said predetermined portions of said blank metal substrate are not shaped by said second force.”

Newly added Claim 14 further limits the method of Claim 1 by requiring “supplying elastomeric material to opposing outer surfaces of said blank metal substrate.” These limitations are not found in the prior art of record.

VI. Conclusion

In view of the above, each of the presently pending claims in this application is in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass

Application No.: 09/942,250

Docket No.: 60680-1187

this application to issue. Applicant believes that no fee is due with this response. However, if any fee is due, please charge our Deposit Account No. 18-0013, under Order No. 60680-1187 from which the undersigned is authorized to draw.

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Respectfully submitted,

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